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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,145	09/11/2003	L. Harrison Bernbaum	29864/38509	4979
4743	7590	12/17/2004	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			MAI, TRI M	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/660,145

Applicant(s)

BERNBAUM ET AL.

Examiner

Tri M. Mai

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-15 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. Claims 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 09/07/04.

Applicant elected the embodiment of Fig. 3a directed to the luggage structure with hinges 14g. (Specification, pg. 8, ln. 7-15: *In the embodiment of FIGS. 1-3 the hinge line 14g may be defined solely by a flexible portion 10g of the sidewall 10a, while the hinge line 16g may be formed solely by a flexible portion 10h of the sidewall 10c, with no actual physical hinge structure being employed. It will be appreciated that the flexible portions 10g and 10h are disposed substantially in line with the interface 18 between the lower compartment 12 and the first and second upper compartments 14 and 16. Alternatively, the hinge lines 14g and 16g may be defined by actual physical hinge structures as shown and described below with respect to the other embodiments*).

Clearly the hinge line in the elected embodiment directed to a defined solely by a flexible portion of the sidewall 10a. Thus claims 16-18 are directed to a hinge with a reinforcement member are withdrawn. Claims 19-20 are directed to a fabric strap are withdrawn.

Furthermore, it is noted that applicant discloses numerous combinations of hinges and luggage structures what would require separate searches and separate consideration of each combination. Thus, the election is proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant is requested to amend **Cross Reference to Related Application** to update the current status of related prior applications.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification fails to provide proper antecedent basis for the term “extended portions”. In other words, the specification fails to identify what elements as disclosed are extended portions.

4. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,644,448. Although the conflicting claims are not identical, they are not patentably distinct from each other because It would have been obvious to one of ordinary skill in the art to eliminate the limitations of the extensible cord when it is not needed.

5. Claim 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what comprises the “extended portions” in claim 15. A proper response to this rejection must include identification of all elements that applicant regards as “extended portions” and provide explanations of how are these “extended portions” are supported by the specification.

6. Claims 1-4, 10-12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tinderman (792183) in view of Rekuc et al. (5435423). Tinderman teaches a soft-sided carrying case comprising a primary compartment defined by the interior of portion 15, the primary compartment including a plurality of sidewalls, a top wall (it is noted that applicant defines the top wall broadly, i.e., the top wall comprises the narrow portions 12 f surrounding at least a portion of the top. In this case, Tinderman teaches a top narrow portion above portion 5) and a

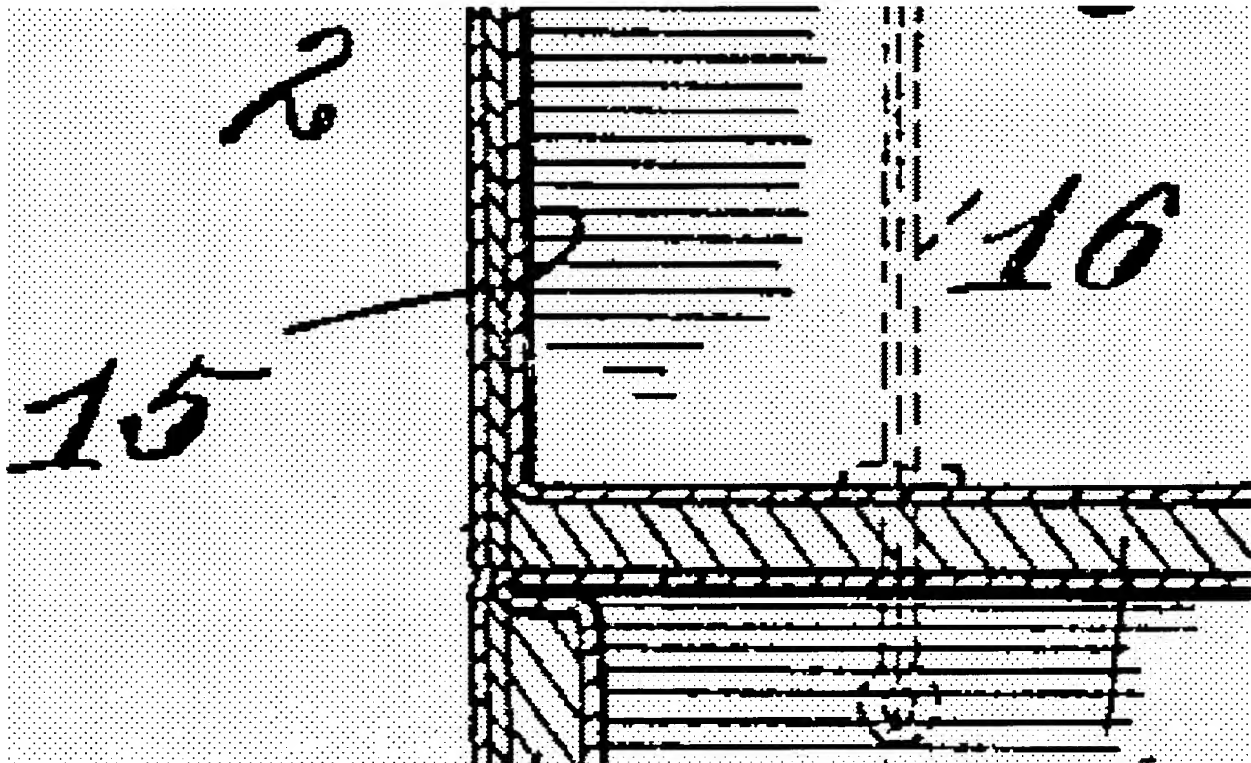
Art Unit: 3727

bottom wall, a first one of the sidewalls and a second one of the sidewalls each formed of a flexible fabric material including an extended portion, a first upper compartment defined by the interior of portion 15, the first upper compartment having a plurality of sidewalls, a top wall, and a bottom wall, one of the sidewalls of the first upper compartment being formed of the same contiguous piece of flexible fabric material as the first sidewall of the primary compartment, the sidewall of the first upper compartment and the first sidewall of the primary compartment defining a first hinge line generally adjacent to an interface defined between the primary compartment and the first upper compartment, the first hinge line permitting the first upper compartment to pivot about the first hinge line between a folded position and an unfolded position; and a second upper compartment, the second upper compartment having a plurality of sidewalls, a top wall, and a bottom wall, one of the sidewalls of the second upper compartment being formed of the same contiguous piece of flexible fabric material as the second sidewall of the primary compartment (see drawing below and note the compartments being formed of the same contiguous piece of the outer layer), the sidewall of the second upper compartment and the first sidewall of the primary compartment defining a second hinge line generally adjacent to an interface defined between the primary compartment and the second upper compartment, the second hinge line permitting the second upper compartment to pivot about the second hinge line between a folded position and an unfolded position. Tiderman meets all claimed limitations except for the carrying case including a pair of wheels and an extendable handle.

Rekuc teaches that it is known in the art to provide a luggage with a wheels and an extendable handle. It would have been obvious to one of ordinary skill in the art to provide wheels and an extendable handle in Tiderman as taught by Rekuc to move the luggage easily.

Regarding claims 3-4, note the straps 23 in Tiderman.

Regarding claim 15, it would have been obvious to one of ordinary skill in the art to eliminate the hinges 16 to have the hinge exclusive provided by the extensions of the sidewalls. since it is obvious for one of ordinary skill in this art to eliminate the extra hinge when its function is not desired. See, Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969).



7. Claims 1-6, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Tiderman rejection as set forth above, and further in view of Christie.

Regarding claims 1 and 10, to the degree it is argued that Tiderman does not teach a top wall. Christie teaches that it is known in the art to provide a top wall being a closure flap. It would have been obvious to one of ordinary skill in the art to provide a top wall being the closure flap in Tiderman as taught by Christie to provide added protection to the contents.

Art Unit: 3727

8. Claims 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcoming the double patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (571)272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai  
Primary Examiner  
Art Unit 3727

